

**REMARKS**

Claims 1-30 are pending of which claims 13-24, 27 and 30 are withdrawn. New claim 31 has been added. Applicant requests reconsideration of the application in view of the amendments to the specification and claims and the remarks set forth below.

Paragraphs 4 and 5 of the Office Action (OA) object to the drawings under 37 C.F.R. 1.83 (a). Paragraph 6 of the OA objects to the specification. Paragraph 8 of the OA rejects claims 1-8, 10, 25-26 and 28-29 under 35 U.S.C. §102(b) as being anticipated by Watson (US 5,629,780). Paragraph 10 of the OA rejects claim 12 under 35 U.S.C. §103(a) as being unpatentable over Watson. Paragraph 11 of the OA rejects claims 9 under 35 U.S.C. §103(a) as being unpatentable over Watson, as applied to claims 1 and 8, in view of Pian et al. (US Publication No. 2002/0021754 A1). Paragraph 12 of the OA rejects claims 11 under 35 U.S.C. §103(a) as being unpatentable over Watson, as applied to claims 1 and 8, in view of Lee et al. (US 5,576,767).

Applicant respectfully traverses the objections to the drawings and specification. Additionally, applicant respectfully traverses the prior art rejections of claims 1-12, 25-26 and 28-29. The applied references fail to disclose or suggest the inventions defined by applicant's amended claims, and provide no teaching that would have suggested the desirability of modification to arrive at the claimed invention.

**Objection - Drawings**

Paragraph 4 of the OA objects to the drawings under 37 C.F.R. 1.83 (a) and references text set forth on page 2, paragraph [0008] and page 3, paragraph [00010] of the specification. The rejection states that the "so-called '*third set of parameter*' (singular) and '*third set of parameters*' (plural) are not shown." In response to this objection, the specification has been amended to remove the reference to the third set of parameter(s) and to track the language to the illustration of FIG. 4 and related text.

Paragraph 5 of the OA objects to the drawings under 37 C.F.R. 1.83(a) and states that the "last five lines of each of claims 2, 26 and 29 must be shown or the feature(s) canceled from the claim(s)." In response to this objection, the claims have been revised to remove the reference to the third set of parameter(s) and to track the language to the illustration of FIG. 4 and related text.

In view of the foregoing amendments to the specification and claims and corresponding remarks, applicant respectfully requests that the objections to the drawings be withdrawn.

### **Objection - Specification**

Paragraph 6 of the OA objects to the specification and references text set forth on page 2, paragraph [0008] and page 3, paragraph [00010] of the specification. The rejection states that the “so called ‘third set of parameter’ (singular) and ‘third set of parameters’ (plural) are not shown. As set forth above, the specification has been amended to remove the reference to the third set of parameter(s) and to track the language to the illustration of FIG. 4 and related text.

In view of the foregoing, applicant respectfully requests that the objection to the specification be withdrawn.

### **Rejection – 35 U.S.C. §102(b) as being anticipated by Watson**

Paragraph 8 of the OA rejects claims 1-8, 10, 25-26 and 28-29 under 35 U.S.C. §102(b) as being anticipated by Watson (US 5,629,780). Applicant respectfully traverses this rejection.

### **The Watson Reference**

Watson discloses in the Abstract,

[A] method for performing color or grayscale image compression that eliminates redundant and invisible image components... The present invention adapts or customizes the quantization matrix to the image being compressed. The quantization matrix comprises visual masking by luminance and contrast techniques and by an error pooling technique all resulting in a minimum perceptual error for any given bit rate, or minimum bit rate for a given perceptual error. (Emphasis added)

### **Applicant's invention**

Applicant's embodiments allow for the generation of a set of parameters for encoding digital image information. The parameters can be determined to result in a compressed data bit rate below a selected threshold such that a decoder will not stop

during playback of a film. (See paragraph [0006].) Therefore, the compressed data bit rate can be controlled and limited based on the parameters.

Independent claim 1 has been amended to positively recite an image compressor to compress the digital image information using the set of parameters, when the set of parameters is determined to result in a compressed data bit rate below a selected threshold so that a decoder will not stop during playback. No corresponding feature is disclosed or described by Watson. In this regard, Watson's compression is based on a "minimum perceptual error for any given bit rate", as set forth above.

Independent claims 25 and 28 have been amended with similar language. Thus, the remarks set forth above in relation to claim 1 equally apply to independent claims 25 and 28.

In the absence of the foregoing disclosure recited in amended independent claims 1, 25 and 28, Watson cannot anticipate these claims. See, e.g., Continental Can Co. USA v. Monsanto Co., 20 USPQ2d 1746, 1748 (Fed. Cir.1991). Furthermore, Watson does not suggest the claimed subject matter and, therefore, would not have motivated one skilled in the art to modify Watson's apparatus to arrive at the claimed invention.

Claims 2-8, 10, and 26 and 29 depend on and contain all of the limitations of amended independent claims 1, 25 and 28, respectively, and, therefore, distinguish from Watson at least in the same manner as claims 1, 25 and 28.

Applicant believes that many of the dependent claims 2-8, 10, 26 and 29 recite other features that are clearly lacking from the applied reference, and do not acquiesce to the rejection of these claims.

In view of the foregoing, applicant respectfully requests that the rejection of claims 2-8, 10, 25-26 and 28-29 under 35 U.S.C. §102(b) as being anticipated by Watson be withdrawn.

#### **Rejection -- 35 U.S.C. §103(a) as being unpatentable over Watson**

Paragraph 10 of the OA rejects claim 12 under 35 U.S.C. §103(a) as being unpatentable over Watson. Applicant respectfully traverses this rejection.

Watson does not disclose or suggest the subject matter recited in amended independent claim 1 as set forth above for the rejection under 35 U.S.C. §102(b). Claim 10

depends on and contains all of the limitations of amended independent claim 1 and, therefore, distinguishes from Watson at least in the same manner as amended claim 1.

In view of the foregoing, applicant respectfully requests that the rejection of claim 12 under 35 U.S.C. §103(a) as being unpatentable over Watson be withdrawn.

**Rejection — 35 U.S.C. §103(a) as being unpatentable over  
Watson in view of Pian et al. (US Publication No. 2002/0021754 A1)**

Paragraph 11 of the OA rejects claim 9 under 35 U.S.C. §103(a) as being unpatentable over Watson, as applied to claims 1 and 8, in view of Pian et al. (US Publication No. 2002/0021754 A1). Applicant respectfully traverses this rejection.

Watson does not disclose or suggest the subject matter recited in amended independent claim 1 as set forth above for the rejection under 35 U.S.C. §102(b). Claim 9 depends on and contains all of the limitations of dependent claim 8, which depends directly on amended independent claim 1 and, therefore, distinguishes from Watson at least in the same manner as amended claim 1.

Pian does not cure the deficiencies of Watson. In this regard, Pian does not disclose or suggest an image compressor to compress the digital image information using the set of parameters, when the set of parameters is determined to result in a compressed data bit rate below a selected threshold so that a decoder will not stop during playback, as recited in amended independent claim 1. Accordingly, one of ordinary skill in the art would not have been led to modify the references to attain the claimed subject matter.

In view of the foregoing, applicant respectfully requests that the rejection of claim 9 under 35 U.S.C. §103(a) as being unpatentable over Watson in view of Pian be withdrawn.

**Rejection — 35 U.S.C. §103(a) as being unpatentable over  
Watson in view of Lee et al. (US 5,576,767)**

Paragraph 12 of the OA rejects claim 11 under 35 U.S.C. §103(a) as being unpatentable over Watson, as applied to claims 1 and 8, in view of Lee et al. (US 5,576,767). Applicant respectfully traverses this rejection.

Watson does not teach the features of the claimed invention as described in relation to amended claim 1. Lee was not relied upon for any of the deficiencies in Watson asserted by Applicant above. Hence, any combination of Watson in view of Lee would not produce Applicant's claimed invention.

**CONCLUSION**

In view of the foregoing amendments and discussion, Applicants respectfully submit that all claims in this application are in condition for allowance. Applicants respectfully request reconsideration and prompt allowance of all pending claims. Please charge any additional fees or credit any overpayment to deposit account number **17-0026**. The Examiner is invited to telephone the below-signed attorney to discuss this application.

Respectfully submitted,

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Dated: October 08, 2007

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